



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,839	04/02/2001	Masao Tsuruta	Q60559	8477

7590 10/01/2002

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3213

EXAMINER

DEXTER, CLARK F

ART UNIT	PAPER NUMBER
----------	--------------

3724

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/822,839

Applicant(s)
Tsuruta

Examiner
Clark F. Dexter

Art Unit
3724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3724

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, drawn to a manufacturing apparatus, classified in class 83, subclass 78.
 - II. Claim 5, drawn to a method of manufacturing a plurality of sheets, classified in class 271.
 - III. Claims 6, 10, 11; and 7-8, drawn to a manufacturing apparatus with a specific support member configuration, classified in class 271.
 - IV. Claims 6, 10, 11; and 9, drawn to a manufacturing apparatus with a specific second presser member configuration, classified in class 269.
 - V. Claim 12, drawn to a method of manufacturing a plurality of sheets, classified in class 83, subclass 13.
 - VI. Claims 13-16, drawn to a manufacturing apparatus, classified in class 83, subclass 401.
2. Claims 6-11 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific support member configuration of Group III). It is noted that if claim 6 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 6-11 will be considered. It is further noted that claim 6 is

Art Unit: 3724

listed as part of groups III and IV but is not considered to be part either of these groups. Rather, claim 6 recites subject matter that is common to both groups III and IV and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group).

Further, because claim 6 includes subject matter that is common to both groups III and IV, it is not considered to be independent or distinct from either of these groups. Therefore, claim 6 will be examined upon election of one of groups III or IV.

3. The inventions are distinct, each from the other because of the following reasons:

Method Groups (Groups II and V) vs Apparatus Groups (Groups I, III, IV and VI)

4. Inventions of Groups II and V are related to the inventions of Groups I, III, IV and VI as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be practiced by another materially different apparatus or by hand; for example, the process of Group V does not require the specific structure set forth in Group VI.

It is noted that the process of Group II does not appear to be patentably distinct from the apparatus of Groups III or IV. Therefore, Group II will be examined with either Group III or IV upon election of one of these groups.

Art Unit: 3724

Method Group II vs Method Group V

5. Inventions of group II and group V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the holding and/or pressing steps of group II could be employed without the cutting steps of group V; and conversely, the cutting steps of group V could be employed without the holding and/or pressing steps of group II. See MPEP § 806.05(d).

Apparatus Groups I, III, IV and VI

Group I vs Groups III, IV and VI:

6. Inventions of group I and groups III, IV and VI are related as combination and subcombination. Inventions in this relationship are distinct if there is evidence that the combination does not rely on the subcombination for patentability. See MPEP 805.05(c), example 3. Groups III and/or IV is evidence that the combination of group I does not rely on the cutting device configuration of group VI for patentability; and conversely, group VI is evidence that the combination of group I does not rely on the specific film transport mechanism configuration of groups III and/or IV for patentability.

Art Unit: 3724

Groups III, IV and VI:

7. Inventions of group III and group IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the specific support member configuration of group III could be employed without the specific second presser member configuration of group IV; and conversely, the specific second presser member configuration of group IV could be employed without the specific support member configuration of group III. See MPEP § 806.05(d).

8. Inventions of groups III and IV are related to the invention of group VI subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the presser members of groups III and IV could be employed without the specific cutting device configuration of group VI; and conversely, the specific cutting device configuration of group VI could be employed without the presser members of groups III and IV. See MPEP § 806.05(d).

Species

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 3724

10. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A - Figure 1; and

Species B - Figure 10.

Upon election of Group I, V or VI, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 3724

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404. The examiner's typical work schedule is Monday, Tuesday, Thursday and Friday, and he can be reached during normal business hours on these days.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Allan Shoap, can be reached at (703)308-1082.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3590; informal/draft papers - (703)305-9835.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cf
September 27, 2002